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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,262	03/21/2001	Charles Q. Meng	04676.105051 (ATH114US)	4560
20786	7590	01/22/2004	EXAMINER	
KING & SPALDING 191 PEACHTREE STREET, N.E. ATLANTA, GA 30303-1763			VOLLANO, JEAN F	
			ART UNIT	PAPER NUMBER
			1621	5
DATE MAILED: 01/22/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/815,262

Applicant(s)

MENG ET AL.

Examiner

Jean F. Vollano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23,28-38,40-42,44-50,52-54,56-58,60-62,64-66,68-70 and 72-76 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6,7,12-15,28 and 72-76 is/are rejected.
- 7) ☒ Claim(s) 8,10,11,16-19,22,23,31,34 and 35 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims withdrawn from consideration are 3-5,9,20,21,29,30,32-33,36-38,40-42,44-50,52-54,56-58,60-62 and 68-70.

DETAILED ACTION

1. The amendment and the terminal disclaimer filed 12/1/2003 has been entered. Claims 1-23, 28-38, 40-42, 44-50, 52-54, 56-58, 60-62, 64-66, 68-70, and 72-76 are pending. Claims 3-5, 8-13, 15-23, 29-38, 40-42, 44-50, 52-54, 56-58, 60-62, 64-66 and 68-70 are withdrawn from consideration as being drawn to non elected subject matter.
2. The terminal disclaimer in reference to copending applications 10/114,351 and 10/115,206 the double patenting rejection over the two copending applications is withdrawn.
3. The rejection of the 102(b) has been overcome by placing the priority data in the first sentence of the specification which shows that the earliest priority date is now May 14, 1998 for the application which eliminates the WO981662 from being prior art.
4. The examiner will now search until another species is found or until the whole compound claim section which was elected (non saccharide, carbohydrates etc Z= (i) or (ii)) has been searched (i.e. Z=(iii) –(viii). The examiner will now include claims 1 wherein Z is (iii) , (iv), (v), (vi), (vii), and (viii). Therefore in the following search these claims are now pending and no longer withdrawn from consideration. Claims 1, 2, 6, 7, 8, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 22, 23, 28, 30, 34, 35, 72-76 are now being examined. Claims 3-5, 9, 20-21, 29, 31-33 and 36-38, 40-42, 44-50, 52-54, 56-58, 60-62, 64-66 and 68-70 are withdrawn from consideration as being drawn to non elected subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-2, 6 –7, 12, 13, 14, 15, 28, and 72-76 rejected under 35 U.S.C. 102(e) as being anticipate by Somers (US 6,121,319- earliest date is May 14, 1997) .

Sommers teaches a compound of formula I wherein Z is a compound of (viii) wherein X is $(CR_2)_{1-6}X$ wherein there is a $CH_2CH(OH)$ which is CR_2CR_2 wherein three instances the R_2 is a hydrogen and the last R_2 is a OH. (The claim reads on R is independently). Or CR_2CR_2 wherein all the R_s are hydrogen. The R_{a-d} are all tertbutyl groups.

When Sommers teaches that X is the heteroaryl oxirane or a substituted oxirane and the compounds are used in a pharmaceutical composition then the claims are fully anticipated (see examples and attached structure sheet).

Sommers teaches additional compounds that read on the instant formula wherein R_{a-Rc} is tert butyl $(CR_2)_{1-6}X$ and CR_2 is CH_2 or wherein there is a CH_2CH_2 and X is a substituted aryl. Sommers teaches compounds of the instant formula wherein R_{a-Rc} is tert butyl and Z is a (vi) wherein X is a polyhydroxylated C_4 or C_3 chain with 4 or 3 hydroxyl groups respectively. Sommers teaches a compound of the instant formula wherein the R_{a-Rc} groups are tert butyl and Z is (CR_2) which is 6carbons long and substituted with 4 hydroxides. The compound which has a isoindole dione and 4 CH_2 groups as Z also is exemplified as well as Z being (iv)

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CH₂OCOEt. Or (CH₂)₃ C(O) OMe (see examples or attached examples structurally drawn).

Also the pharmaceutical composition of these compounds is taught.

Claims 1-2, 6-7, 12, 13, 14, 15, 28, and 72, rejected under 35 U.S.C. 102(e) as being anticipate by Somers (US 6,548,699- earliest date is May 14, 1997) .

US 6,548,699 by Sommers is also available under 102(e) and teaches compounds of Z is (vi) and is cumulative to (US 6,121,319). Herein the Z =(vi) is exemplified as CR₂ with 4 and 6 carbons and 3 and 5 hydroxides respectively and therefore anticipates the claims.

5. Claim 8 with a terminal sulfonic acid, claims 10 and 11 with a terminal phosphonic acid (not an ester as is in US 6,121,319), claim 16, claim 17, 18, 19, 22, 23, 31, 34, and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The examiner notes that it would hasten prosecution if the non elected subject matter were taken out of the independent claim and the non elected claims were canceled.

Applicant's amendment/terminal disclaimer necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

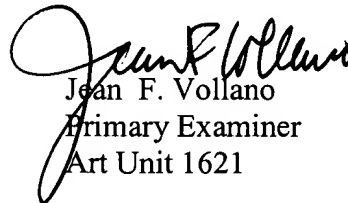
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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean F. Vollano whose telephone number is 703-305-4483. The examiner can normally be reached on Monday-Thursday 6:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 703-308-4532. The fax phone number for the organization where this application or proceeding is assigned is 703-308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


Jean F. Vollano
Primary Examiner
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January 14, 2004